

FULL TEXT OF CASES (USPQ2D)

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Martin v. Mayer (CA FC) 3 USPQ2d 1333 Martin v. Mayer

**U.S. Court of Appeals Federal Circuit
3 USPQ2d 1333**

Decided June 30, 1987

No. 87-1073

Headnotes

PATENTS

1. Practice and procedure in Patent and Trademark Office — Interference — Burden of proof (§ 110.1707)

Copier of claims, rather than patentee, has burden of proof, in interference proceeding, of demonstrating, by clear and convincing evidence, that disclosure which is relied upon supports copied claims which became interference counts, and such burden requires copier initially to present prima facie case of support for copied claim, and burden of going forward shifts to patentee only after such showing has been made.

2. Practice and procedure in Patent and Trademark Office — Interference — In general (§ 110.1701)

Only inquiry, in considering whether copier has right to make copied claim corresponding to count for interference purposes, is whether copier's disclosure contains support for all material limitations of claim as presented in patent, nor can patentee's disclosure be drawn upon to fill gaps in that of copier.

Case History and Disposition:

Appeal from Patent and Trademark Office Board of Patent Appeals and Interferences.

Patent interference between Albert R. Martin, Patent No. 4,347,487, filed November 25, 1980, and Ferdy P. Mayer, application, Serial No. 202,654, filed October 31, 1980. From decision holding that applicant Mayer's specification supported count 6 in terms of 35 USC 112, patentee Martin appeals. Reversed.

Attorneys:

Herbert H. Mintz of Finnegan, Henderson, Farabow, Garrett & Dunner (Jerry D. Voight, with him on brief), all of Washington, D.C., for appellant Martin.

Steven B. Kelber of Oblon, Fisher, Spivak, McClelland & Maier, both of Arlington, Va., for appellee Mayer.

Judge:

Before Davis and Newman, Circuit Judges, and Nichols, Senior Circuit Judge.

Opinion Text**Opinion By:**

Newman, Circuit Judge.

Albert R. Martin appeals that part of the decision of the Board of Patent Appeals and Interferences (the "Board") relating to priority of invention of count 6 of Interference No. 101,182, between Martin's U.S. Patent No. 4,347,487 filed November 25, 1980, and appellee Ferdy P. Mayer's patent application Serial No. 202,654 filed October 31, 1980. Mayer is the senior party, having an effective filing date of March 12, 1979. The question on appeal is whether Mayer has the right, in terms of 35 U.S.C. § 112 ¶ 1, to make the claim that is interference count 6.

Background

The subject matter is high frequency attenuation cables having an electrically conductive outer jacket surrounding inner layers of absorptive, dielectric, and conductive media. Counts 1-4 are directed to the structure of the individual cables. Count 6 is directed to a harness comprising a plurality of such cables. Priority as to counts 1-4 and 6, all the counts, was awarded to Mayer. Issues relating to counts 1-4 are raised in connection with the appeal of count 6. Illustrative count 1, and count 6, are as follows:

1. A high frequency attenuation cable comprising:

a conductor;

a high frequency absorption medium for attenuating high frequency energy through the cable, the absorption medium surrounding the conductor;

dielectric surrounding the absorption medium;

electrically conductive shielding means surrounding the dielectric; and

electrically conductive outer jacketing means surrounding the shielding means.

6. A high frequency attenuation harness comprising a plurality of high frequency attenuation cables wherein each cable comprises:

a conductor;

a high frequency absorption medium for attenuating high frequency energy through the cable, the absorption medium surrounding the conductor;

dielectric surrounding the absorption medium;

electrically conductive shielding means surrounding the dielectric;

each cable being provided with an electrically conductive outer jacketing means surrounding the shielding means

The cable of count 1 is illustrated in the drawings of the parties as follows:

Tabular, graphic, or textual material set at this point is not available. Please consult hard copy or call BNA PLU at 1-800-452-7773 or 202-452-4323.

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The pertinent text in Mayer's specification states that "figures 2a, 2b, and 2c illustrate three typical constructions RFI-suppressor cables, to which the present invention

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may be advantageously applied", and for Figure 2a adds:

Cover 3" is an insulating (or conductive) protection.

On the basis of this disclosure, the Board awarded priority to Mayer with respect to counts 1-4. No appeal was taken from that part of the Board's decision.

The harness comprising a plurality of cables, count 6, is illustrated by Martin as follows:

Tabular, graphic, or textual material set at this point is not available. Please consult hard copy or call BNA PLU at 1-800-452-7773 or 202-452-4323.

Mayer has no corresponding drawing, and Mayer's text does not discuss a plurality of cables in a harness. Mayer relies on the text associated with his Figure 2a, which states:

It is evident that a multiple wire coaxial structure can be achieved by the same means.

The Board held that Mayer's disclosure complies with the requirements of 35 U.S.C. § 112 ¶ 1, 1 on the basis that the harness of electrical cables is "conventional". The Board did not discuss that a harness is not disclosed in Mayer's specification, and by its decision the Board did not require such disclosure in order for Mayer to make the copied claim and to be awarded priority thereto.

Burden of Proof

The Board assigned the evidentiary burdens as follows:

Martin has the burden of going forward and Mayer has the burden of persuasion on the issue of right to make. *Holmes v. Kelly*, 586 F.2d 234, 199 USPQ 778 (CCPA 1978).

Martin argues that the Board improperly placed the burden of proof on Martin, the patentee, and did not require that Mayer establish his right to make the copied claim by clear and convincing evidence. Martin states that the Board erroneously relied on *Holmes*, which Martin says is no longer applicable because it was decided at the time there were two separate boards (for patent appeals and patent interferences).

In *Holmes* the Board of Appeals had held ex parte that Holmes' disclosure supported the claim; and the court held that this Board of Appeals decision was not binding in the subsequent interference proceeding. As the court said *Holmes*, "at most, Holmes can argue that the burden of going forward shifted" because of the Board of Appeals decision. *Id.* at 236, 199 USPQ at 781. Procedurally, the court treated the Board of Appeals' decision "at most" as equivalent to a prima facie case in favor of Holmes, such that the burden of going forward might shift from the copier to the patentee. However, since support for the count of an interference is ancillary to priority, *Sze v. Bloc*, 458 F.2d 137, 141, 173 USPQ 498, 501 (CCPA 1972), it was the Board of Patent Interferences that was charged with determining the right to make the count.

In the case at bar there is no prior Board of Appeals decision on Mayer's support for the claim of count 6. An examiner's decision to allow the copied claim to Mayer for interference purposes does not satisfy Mayer's threshold burden in the interference proceeding of presenting a prima facie case of compliance with section 112 paragraph 1. The Board thus misapplied *Holmes* to the case before us.

[1] The Board placed on the patentee Martin the burden of presenting a prima facie case that Mayer could *not* make count 6:

We . . . find that Martin has not sustained his burden of going forward with sufficient evidence to prove, *prima facie*, that Mayer has no right to make his involved claims.

Thus the Board erred. It is Mayer, the copier of claims from Martin's patent, who has the burden of proving, by clear and convincing evidence, that "the disclosure on which he relies supports the copied claims which became the interference counts". *Burson v. Carmichael*, 731 F.2d 849, 852, 221 USPQ 664, 666 (Fed. Cir. 1984). See also *DeGeorge v. Bernier*, 768 F.2d 1318, 1321, 226 USPQ 758, 760 (Fed. Cir. 1985).

This burden requires, as the first step, that Mayer go forward and present a prima facie case of support for the copied claim. This prima facie case must itself be established by clear and convincing evidence. If such prima facie case of support for the count is not made, the patentee Martin will prevail without more.

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The burden of going forward will shift to the patentee only after the copier has prima facie shown the right to make the copied claim. *Woods v. Tsuchiya*, 754 F.2d 1571, 1575, 225 USPQ 11, 13 (Fed. Cir.), *cert. denied*, 106 S.Ct. 81 (1985). It is immaterial whether the copier has the senior or junior filing date. *Holmes*, 586 F.2d at 236, 199 USPQ at 781. Thereafter, if Martin as patentee produces evidence or argument in rebuttal, the PTO must view the entirety of the evidence and determine whether Mayer has met his burden of persuasion, clearly and convincingly that he has the requisite support in terms of 35 U.S.C. § 112 ¶ 1. This ultimate burden never shifts.

Analysis

The copier of claims for interference purposes must show support in the copier's specification for every material limitation of the proposed count. 2 *Snitzer v. Etzel*, 531 F.2d 1062, 1065, 189 USPQ 415, 417 (CCPA 1976). Mayer asserts that the "harness . . . of cables" of count 6 is supported because the terms "wire" and "cable" are used "interchangeably" in his specification, referring to page 3, lines 7-8, "Wires and cables using such mixtures", and his claim 1 as filed, "A high frequency attenuation wire or cable". Martin responds that the plain reading of Mayer's specification is that "wires" and "cables" are distinct articles and are not used interchangeably. Martin argues that "multiple wire" in Mayer's specification does not mean "multiple cable", and that Mayer's words "a multiple wire coaxial structure" plainly refer to a single coaxial cable having multiple wires. Martin adduced expert testimony by deposition of Dr. Frank Doljack, who testified that wires and cables were understood in the art to mean different things, and that the term "multiple wire coaxial structure" was understood as referring to a single cable and not a plurality of cables. Martin thus argues that the words in Mayer's specification do not describe a harness of cables, and particularly not a harness of cables having conductive outer